

Remarks

Applicants respectfully request reconsideration of the present U.S. Patent application as amended herein. Claims 17, 22 and 28 have been amended. No claims have been added. Claims 1-16, 29-32 and 37 are canceled herein. Claim 2 was previously canceled. Thus, claims 17-28, 33-36 and 38-45 are pending.

CLAIM REJECTIONS - 35 U.S.C. § 103(a)

Claims 1, 4, 14, 17, 22 and 28-45 were rejected as being unpatentable over U.S. Patent No. 5,848,413 issued to Wolff, et al. (*Wolff*) in view of U.S. Patent No. 5,692,048 issued to Gormish, et al. (*Gormish*) and further in view of U.S. Patent No. 6,584,508 issued to Epstein, et al. (*Epstein*) and further in view of U.S. Patent No. 6,742,116 issued to Matsui (*Matsui*) and further in view of U.S. Patent No. 5,870,552 issued to Dozier (*Dozier*). Claims 1, 4, 14, 28-32 and 37 have been canceled. Therefore, the rejection of claims 1, 4, 14, 28-32 and 37 is moot.

Claim 17 recites:

- selecting one or more of the multiple saved electronic documents for publication over a network;
- transforming the one or more of the selected electronic documents to meet predetermined format- and content-based standards for publication if the one or more selected electronic documents do not meet the standards for publication;
- transmitting to one or more recipients authorization information corresponding to the selected electronic documents;
- transmitting a document resource identifier, automatically and in association with publication, to one or more independent World Wide Web indexing services; and
- the server allowing access to a selected subset of the electronic documents by using a security key and the document resource identifier.

Thus, Applicants claim selecting a publishing a subset of electronic documents by selectively formatting and transmitting a document identifier and authorization information to one or more recipients and automatically, in association with publication, causing the document identifier to be transmitted to one or more independent World Wide Web indexing services. Claims 22 and 28 recite similar limitations.

The section of *Wolff* cited in the Office Action discloses a gateway that receives a fax document and transforms the fax document to a hypertext document. See col. 7, lines 29-30 and 40-49. The documents are stored and identifiers are provided. See col. 7, lines 58-60. However, *Wolff* does not teach or suggest automatically, in association with publication, causing the document identifier to be transmitted to one or more independent World Wide Web indexing services.

Gormish is cited to teach a fax machine that stores a certain number of faxes in order to have archived documents to search. See page 3 of the Office Action. Whether or not this is an accurate characterization of *Gormish*, nothing in *Gormish* appears to teach or suggest automatically, in association with publication, causing the document identifier to be transmitted to one or more independent World Wide Web indexing services.

Epstein is cited to teach content-based filtering. However, *Epstein* is not cited to teach, nor does *Epstein* teach, automatically, in association with publication, causing the document identifier to be transmitted to one or more independent World Wide Web indexing services. Further, *Epstein* does not appear to disclose format- and content-based standards transformation of documents.

Matsui is directed to a security strategies for electronic “conversations,” but not automatically, in association with publication, causing the document identifier to be transmitted to one or more World Wide Web indexing services. That is, *Matsui* is directed to generating and using security keys for use in terminals that operate as an electronic conference room. See Abstract; col. 2, lines 27-44. However, nothing in *Matsui* suggests use with published documents that are stored, transformed and published as claimed. Therefore, Applicants submit that it would not have been obvious to one of skill in the art to combine *Matsui* with *Wolff*, *Gormish* and *Epstien*.

Dozier is cited to teach indexing of documents. See Office Action at page 5. *Dozier* does disclose indexing of documents. See col. 14, line 64 to col. 15, line 2. However, this indexing is not an independent World Wide Web indexing service as recited in the claims. Therefore, even if *Dozier* is properly combined with *Wolff*, *Gormish*, *Epstien* and *Matsui*, the resulting combination does not result in the claimed invention.

Claims 33, 34 and 40-42 depend from claim 17. Claims 35, 36 and 43-45 depend from claim 28. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 4 and 29-45 are not rendered obvious by the combination of *Wolff*, *Gormish*, *Epstien*, *Matsui* and *Dozier* for at least the reasons set forth above.

Claims 8-13, 15, 16, 18, 23 and 27 were rejected as being unpatentable over *Wolff* in view of *Gormish*, *Epstein* and *Matsui* and further in view of U.S. Patent No. 6,188,673 issued to Bauer, et al. (*Bauer*). Claims 8-13, 15 and 16 have been canceled. Therefore,

the rejection of claims 8-13, 15 and 16 is moot. For at least the reasons set forth below, Applicants submit that claims 18, 23 and 27 are not rendered obvious by the cited references.

Bauer is cited to teach the capability to determine and communicate page hits and logging. See Office Action at page 6. However, *Bauer* is not cited to cure, nor does *Bauer* cure, the deficiencies of the combination of *Wolff*, *Gormish*, *Epstein*, *Matsui* and *Dozier* set forth above. Therefore, no combination of *Wolff*, *Gormish*, *Epstein*, *Matsui*, *Dozier* and *Bauer* can teach or suggest the invention as claimed in claims 18, 23 and 27.

Claims 5-7, 19-21 and 24-26 were rejected as being unpatentable over *Wolff*, *Gormish*, *Epstein*, *Matsui* and *Dozier* and further in view of U.S. Patent No. 6,317,777 issued to Skarbo, et al. (*Skarbo*). Claims 5-7 were canceled. Therefore, the rejection of claims 5-7 is moot. For at least the reasons set forth below, Applicants submit that claims 19-21 and 24-26 are not rendered obvious by the cited references.

Skarbo is cited to teach deleting a document or preventing access to the document upon certain conditions. See Office Action at page 9. However, *Skarbo* is not cited to cure, nor does *Skarbo* cure, the deficiencies of the combination of *Wolff*, *Gormish*, *Epstein*, *Matsui* and *Dozier* set forth above. Therefore, no combination of *Wolff*, *Gormish*, *Epstein*, *Matsui*, *Dozier* and *Skarbo* can teach or suggest the invention as claimed in claims 19-21 and 24-26.

Conclusion

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 17-28, 33-36 and 38-45 are in condition for allowance and

Application No. 09/398,229
Amendment dated October 31, 2007
Response to Office Action of September 24, 2007

Atty. Docket No. 74451.P100
Examiner Boutah, Alina A.
TC/A.U. 2143

such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
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Date: October 31, 2007

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